REMARKS

Claims 1-18 are pending in the current application. Applicant has amended claims 1, 9, 15 and 16. Reexamination and reconsideration of all claims are respectfully requested.

Applicant acknowledges and appreciates the indication of allowable subject matter for claims 4, 7-8, 12-13, and 16-18.

CLAIM OBJECTIONS

The Office Action objected claim 16 because of informalities identified by the Examiner. Applicant has amended the typographical errors in claim 16 for reasons unrelated to patentability. Applicant has also corrected minor errors in claim 15 and submits that all claims as amended are properly presented.

35 U.S.C. § 102

The Office Action rejected claims 1-3, 5, and 9-11 under 35 U.S.C. § 102(e) as being anticipated by Kulkarni et al., U.S. Patent 6,775,423 ("Kulkarni"). Applicant has amended independent claims 1 and 9.

Kulkarni discloses a method and system for incrementally updating a first image in flash memory of a device by downloading a differences file that identifies differences between the first image and a second image and applying the differences file to the first image to create the second image in the flash memory. (Abstract)

Kulkarni goes on to further describe the use of associating a header with a data section within a 'difference file' and includes information that said data section is to be either added or copied to create the second image. Kulkarni spells out in the passage at Colum 5 lines 51-59:

> The differences file 120 and the modified difference file 124 are composed of two alternating types of sections: data sections contain data from the new image 116 that is not found in the old image 114; copy sections contain data that is found in both the new

> image 116 and the old image 114. To distinguish between the two types of sections, a header is placed at the beginning of each section, the header giving specific information about the section that follows the header.

(Emphasis added)

This passage merely states that the Kulkarni design "difference file" contains two sections or types of information, one section type being new image data to be included and the other section type being old image data to be copied in order to construct the new image. Kulkarni also describes using a header to provide specific information about the data section that follows the header.

In contrast, the present design instruction set comprises SETBLOCK operations. SETBLOCK operation explicitly identifies which operations relate to which blocks. SETBLOCK operations also direct updating of the memory blocks in an order that optimizes the COPY and ADD operations required, optimizes resulting update package size, and allows memory blocks to be updated in a non-sequential order. Further, the SETBLOCK operation, as described in the current specification, identifies the next block to be updated to the decoder. SETBLOCK provides the ability to remove unchanged blocks from the update package entirely, and also to remove trailing COPY operations from a block. Specific examples of sample instruction sets are disclosed in FIG. 8.

SETBLOCK also identifies the next block to be updated to the decoder and allows further functionality, such as non-sequential processing, beyond any functionality disclosed or suggested in Kulkarni. In Kulkarni, when creating a "difference file" the design does not enable or support processing memory blocks independent of processing direction, or processing in a non-sequential manner. Kulkarni only discloses processing from the beginning to the end, and is thus fundamentally significantly more limited than the present SETBLOCK operation. SETBLOCK enables processing non-sequentially, such as from end to beginning.

The present design SETBLOCK operation is more involved and significantly different from the Kulkarni design, which simply includes headers. Applicant's

device and claims operate in a different manner as compared with the Kulkarni design.

Applicant has amended claims 1 and 9 to identify specific aspects of the SETBLOCK functionality that are not shown in Kulkarni, including the non-sequential updating enabled by SETBLOCK and the identification of operations applicable to specific memory blocks. Kulkarni does not use a SETBLOCK operation, or the functional equivalent thereof, to enable non-sequential updating or identify operations applicable to specific memory blocks, as required by amended claims 1 and 9.

Kulkarni therefore does not anticipate claims 1 and 9. Further, all claims depending from claim 1 and 9 are allowable as they include limitations not shown in the cited references and as they depend from an allowable base claim.[1]

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 102.

35 U.S.C. § 103

The Office Action rejected independent claim 15 under 35 U.S.C. §103(a) based on Kulkarni in view of Estakhri et al., U.S. Patent 5,485,313 ("Estakhri")and dependent claims 6 and 14 based on Kulkami in view of Miller '520.

The Office Action notes on page 13 paragraph 28 that the Estakhri reference was erroneously cited in the prior correspondence and that the properly cited reference is U.S. Patent 5,845,313 (Estakhri et. al). Applicant appreciates that the wrong reference was cited and respond according to the corrected reference.

[1] As noted below, claim 6 is rejected under 35 U.S.C. § 103 based on Kulkarni in view of Miller. As dependent claim 6 includes a limitation from claim 1 that is not shown in Kulkarni, and Miller is cited for entirely different reasons, claim 6 includes a limitation not shown in the cited references and is therefore not obvious in view of the cited references.

Applicant has amended claim 15 to recite that said at least two switchable status identifiers are configured to enable restarting update processing if said update processing is interrupted. Neither Kulkarni nor Estakhri show such a design.

The Office Action acknowledges at page 8 that Kulkarni fails to explicitly teach a status array comprised of at least two switchable status identifiers associated with each of the plurality of memory blocks. Thus Kulkarni cannot show one having the status identifier limiatation added in amended claim 15.

The Office Action relies on column 5, lines 4-8 of Estakhri to show the "status array" limitation of claim 15 ("a status array comprised of a least *two switchable status identifiers associated with each* of the plurality of memory blocks"). (Office Action, p. 9) The cited column 5 passage of Estakhri states:

> A collection of information flags is also stored for each nonvolatile memory location 106. The flags include an old/new flag 110, a used/free flag 112, a defect flag 114, and a single/ sector flag 116. Additionally, there is also a data store 122.

This passage simply says that the Estakhri design includes "information flags," including old/new, used/free, and so forth. None of these "information flags" facilitate restarting update processing if said update processing is interrupted as required by the amended claim 15. Thus claim 15 includes a limitation not shown in either of the cited references, either alone or in combination.

Applicant also submits that there is no motivation to combine the incremental updating of an image in FLASH memory system of Kulkarni with the even erase cycle management of FLASH mass storage memory aspects recited in Estakhri. The motivation to combine is alleged to be "to incorporate the process of avoiding erasure cycles as taught by Estakhri into the flash memory of Kulkarni". (Office Action, p. 9). This alleged motivation reads more into either reference than is present in the references themselves, and merely states a broad end result rather than a motivation to combine the teachings of the Kulkarni and Estakhri references. In reality, there is no suggestion in Kulkarni to use a status array and switchable identifiers, nor any

suggestion in Estakhri to employ a difference file and a flash manager resident on a client device for creating a second image in the manner presented in Kulkarni.

Thus in addition to the differences between the claims and the references discussed above, Applicant further disputes the combination of Kulkarni and Estakhri in the manner suggested in the Office Action. Applicant respectfully submits that no motivation to combine the references in the manner suggested is presented within the references themselves. The statement in the Office Action regarding the motivation to combine being for the purpose of "lengthen the life of the flash memory by lessening the number of erasure cycles performed during use" does not demonstrate any motivation to combine the references explicit or implied within the two references themselves, but instead takes the extending the life of the entire mass storage aspect of Estakhri and alleges that it could be applied somehow to Kulkarni. Applicant contends that simply no motivation exists to employ the memory life extending aspect of Estakhri in Kulkarni, and certainly no motivation to employ the incremental updating of an image in FLASH memory of a client device system of Kulkarni is included in Estakhri.

The Federal Circuit has held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital System, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). Without some showing in the prior art that suggests in some way a combination in order to arrive at the claimed invention, it is impermissible to use the Applicants' teaching to search references for the claimed elements and combine them as claimed. *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In Re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *see also*, *Ex Parte Lange*, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947) ("It seems to us that the Examiner is using appellant's disclosure for the suggestion of the combination since there is no suggestion in any of the patents for their combination in the manner claimed by Applicant."); *In re Leonor*, 158 U.S.P.Q. 20, 21 (C.C.P.A. 1968) (the issue is "whether teachings of prior art would, of themselves, and without benefit of applicant's disclosure, suggest [a process] which would make claimed invention obvious...") (emphasis in original). As noted, the Estakhri reference does not suggest combining the mass storage FLASH

memory life extending design disclosed with the incremental updating of an image on a client device aspect of Kulkarni to produce the unique method claimed in Applicant's independent claim 15.

Applicant respectfully submits that the Office Action uses hindsight in rejecting claim 15. It is only through hindsight, after seeing Applicant's disclosure, that it would be considered possible to create the reliable updating system as claimed by the Applicant. With regard to the use of hindsight, or the use of an Applicant's teaching to combine references, the courts have overwhelmingly condemned such combinations and have upheld the validity of patents or claims of patents in which such hindsight was employed to combine the references. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), (condemning the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"); *In re Fine*, 837 F.2d 1044, 1051 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.") Applicants respectfully submit that combination of aspects of the Estakhri reference with the Kulkarni design is merely a hindsight reconstruction of the invention using Applicants' disclosure and attempting to use Applicants' claims as a guide. Such hindsight reconstruction of the claimed system is inappropriate and thus rejection of the independent claim 15 for this reason is improper.

Based upon the totality of the foregoing, Applicant respectfully submits that claim 15, as amended, is allowable over the references of record, and that all claims dependent from claim 15 are allowable as they depend from an allowable base claim.

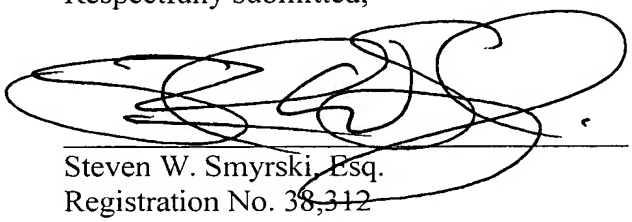
Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. §§ 102 and 103.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims are respectfully requested, and allowance of all the claims at an early date is solicited.

Should it be determined for any reason an insufficient fee has been paid, please charge any insufficiency to ensure consideration and allowance of this application to Deposit Account 502026.

Respectfully submitted,



Date: June 22, 2006

Steven W. Smyrski, Esq.
Registration No. 38,312

SMYRSKI LAW GROUP, A PROFESSIONAL CORPORATION
3310 Airport Avenue, SW
Santa Monica, California 90405-6118
Phone: 310.397.9118
Fax: 310.397.9158